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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,533	12/27/2004	Brad Lewis	03-593-D	2537
20306 7590 07/14/2009 MCDONNELL BOEHNNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
KIM, HEE SOO				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,533

Applicant(s)

LEWIS, BRAD

Examiner

HEE SOO KIM

Art Unit

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67-83, 85 and 86 is/are pending in the application.
4a) Of the above claim(s) 84 and 87 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 67-83, 85 and 86 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to amendment filed on April 28th, 2009.

Claims 67~83, 85, and 86 are pending examination.

Response to Amendment

Claims 67 and 86 have been amended.

Claims 84 and 87 have been cancelled.

Response to Arguments

Applicant's arguments, see Pgs. 6~15, filed 04/28/09, with respect to the rejection(s) of claim(s) 67~83 and 86 under Morris et al. have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Morris et al. in view of Flom et al.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 67~83, 85, and 86 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 70~80 of copending Application No. 10/610,402. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 70 of copending Application No. 10/610,402 contains obvious elements of claim 67 of the instant application and thus anticipate the claim of the instant application. Claim 67 of the instant application therefore are not patentably distinct from the copending application and as such are unpatentable over obvious-type double patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Claims 68~77 of the instant application are the same as claims 71~80 copending Application No. 10/602,410.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 67-83, 85, and 86 are rejected under 35 U.S.C. 102(e) as being anticipated by Morris et al. hereinafter Morris (U.S. 6,112,206) in view of Flom et al. hereinafter Flom (PgPub: 2001/0054087).

Regarding Claim 67,

Morris taught a vehicle diagnostic device comprising:

a first wireless access device that communicates with a replicating device, wherein the replicating device is located on a movable land-based vehicle and replicates information stored at a master device remote from the replicating device (Col. 15, Ln. 45~51, system 310 comprises of portable data collection terminals 312 (wireless device), vehicle 329 for transporting MAS 331 (replicating device), and application server 330 (master server));

a processor; data storage; programming instructions stored at the data storage and executable by the processor to request at least a portion of the replicated information from the replicating device when the replicating device is within communicable proximity of the first wireless access device (Col. 16, Ln. 20~22, 32~37; Col. 17, Ln. 1~5);

wherein the requested information comprises information for configuring at least one vehicle application obtained for the vehicle diagnostic device (Col. 15, Ln. 57~62), and

wherein the replication server provides the requested information to the vehicle diagnostic device in response to the request (Col. 18, Ln. 38~43).

Morris did not specifically teach a user interface that displays a status of whether the information replicated by the replicating device is up-to-date, possibly outmoded, or outmoded.

In an analogous art, Flom taught a system including a portable device for presenting users with portable device applications and content. The portable device includes a cache for caching (replicating) content packages (abstract). A user of Portable device 94 can input search requests and commands. Searchable content packages may be cached on the portable device 94 in intelligent cache 94C. Once a content package has been cached in cache 94C, subsequent user requests on portable device 94 will have local access to the updated cache information [¶36].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, a user interface that displays a status of whether the information replicated by the replicating device is up-to-date, possibly outmoded, or outmoded., as it would eliminate or minimize the need to send requests to server 92 and download information each time a request is made [Flom: ¶36].

Regarding Claim 78,

Morris taught the vehicle diagnostic device is a handheld device (Col. 15, Ln. 45~46, portable data collection terminals 312).

Regarding Claim 79,

Morris taught the first wireless access device is configured to automatically detect a beacon signal from the movable land-based vehicle, and

wherein the vehicle diagnostic devices requests the replicated information in response to the beacon (Col. 16, Ln. 20~22).

Regarding Claim 80,

Morris taught the replicating device receives the information from the master device after the replicating device is transported by the land-based vehicle into a coverage area provided by a second wireless access device (Col. 16, Ln. 22~28).

Regarding Claim 81,

Morris taught the second wireless access device couples the replicating device to the master device when the replicating device is within communicable proximity of the second wireless access device (Col. 16, Ln. 50~56).

Regarding Claim 86,

Morris taught wherein the program instructions further comprise instructions executable by the processor to prompt a user to determine if the replicated information on the replicating device should be updated via a remote network (Col. 18, Ln. 38~60).

Claims 68~77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris in view of Flom and further in view of Lowrey et al. hereinafter Lowrey (U.S. 6,611,740).

Regarding Claims 68,

The combination of Morris and Flom taught all the limitations of claim 67 however, failed to specifically teach the at least one vehicle application comprises an application for measuring a voltage.

Lowrey taught an Internet-based vehicle diagnostic system which measures diagnostic data from vehicles and transmits such data to a website for later access (Col. 5, Ln. 60~64, Fig. 6B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, a vehicle application for measuring data as taught by Lowrey into Morris' data capture system, as it would allow accurate troubleshooting by service centers to determine problems with vehicles (Lowrey, Col. 5, Ln. 18~26).

Regarding Claim 69,

The combination of Morris and Flom failed to specifically teach the measured voltage is a battery voltage.

Lowrey taught an Internet-based vehicle diagnostic system which measures diagnostic data from vehicles and transmits such data to a website for later access (Col. 5, Ln. 60~64, Fig. 6B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, a vehicle application for measuring data as taught by Lowrey into Morris' data capture system, as it would allow accurate troubleshooting by service centers to determine problems with vehicles (Lowrey, Col. 5, Ln. 18~26).

Regarding Claim 70,

The combination of Morris and Flom failed to specifically teach the at least one vehicle application comprises an application for detecting a voltage.

Lowrey taught an Internet-based vehicle diagnostic system which measures diagnostic data from vehicles and transmits such data to a website for later access (Col. 5, Ln. 60~64, Fig. 6B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, a vehicle application for measuring data as taught by Lowrey into Morris' data capture system, as it would allow accurate troubleshooting by service centers to determine problems with vehicles (Lowrey, Col. 5, Ln. 18~26).

Regarding Claim 71,

The combination of Morris and Flom taught all the limitations of claim 67 however, failed to specifically teach the detected voltage is a battery voltage.

Lowrey taught an Internet-based vehicle diagnostic system which measures diagnostic data from vehicles and transmits such data to a website for later access (Col. 5, Ln. 60~64, Fig. 6B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, a vehicle application for measuring data as taught by Lowrey into Morris' data capture system, as it would allow accurate troubleshooting by service centers to determine problems with vehicles (Lowrey, Col. 5, Ln. 18~26).

Regarding Claim 72,

The combination of Morris and Flom failed to specifically teach the at least one vehicle application comprises an application for measuring an idle speed.

Lowrey taught an Internet-based vehicle diagnostic system which measures diagnostic data from vehicles and transmits such data to a website for later access (Col. 5, Ln. 60~64, Fig. 6B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, a vehicle application for measuring data as taught by Lowrey into Morris' data capture system, as it would allow accurate troubleshooting by service centers to determine problems with vehicles (Lowrey, Col. 5, Ln. 18~26).

Regarding Claim 73,

The combination of Morris and Flom failed to specifically teach the at least one of vehicle application comprises an application for detecting an idle speed.

Lowrey taught an Internet-based vehicle diagnostic system which measures diagnostic data from vehicles and transmits such data to a website for later access (Col. 5, Ln. 60~64, Fig. 6B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, a vehicle application for measuring data as taught by Lowrey into Morris' data capture system, as it would allow accurate troubleshooting by service centers to determine problems with vehicles (Lowrey, Col. 5, Ln. 18~26).

Regarding Claim 74,

The combination of Morris and Flom failed to specifically teach the at least one vehicle application comprises an application for measuring an engine rpm.

Lowrey taught an Internet-based vehicle diagnostic system which measures diagnostic data from vehicles and transmits such data to a website for later access (Col. 5, Ln. 60~64, Fig. 6B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, a vehicle application for measuring data as taught by Lowrey into Morris' data capture system, as it would allow accurate troubleshooting by service centers to determine problems with vehicles (Lowrey, Col. 5, Ln. 18~26).

Regarding Claim 75,

The combination of Morris and Flom failed to specifically teach the at least one vehicle application comprises an application for detecting an engine rpm.

Lowrey taught an Internet-based vehicle diagnostic system which measures diagnostic data from vehicles and transmits such data to a website for later access (Col. 5, Ln. 60~64, Fig. 6B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, a vehicle application for measuring data as taught by Lowrey into Morris' data capture system, as it would allow accurate troubleshooting by service centers to determine problems with vehicles (Lowrey, Col. 5, Ln. 18~26).

Regarding Claim 76,

The combination of Morris and Flom failed to specifically teach the at least one vehicle application comprises an application for measuring a cam anomaly.

Lowrey taught an Internet-based vehicle diagnostic system which measures diagnostic data from vehicles and transmits such data to a website for later access (Col. 5, Ln. 60~64, Fig. 6B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, a vehicle application for measuring data as taught by Lowrey into Morris' data capture system, as it would allow accurate troubleshooting by service centers to determine problems with vehicles (Lowrey, Col. 5, Ln. 18~26).

Regarding Claim 77,

The combination of Morris and Flom failed to specifically teach the at least one vehicle application comprises an application for detecting a cam anomaly.

Lowrey taught an Internet-based vehicle diagnostic system which measures diagnostic data from vehicles and transmits such data to a website for later access (Col. 5, Ln. 60~64, Fig. 6B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, a vehicle application for measuring data as taught by Lowrey into Morris' data capture system, as it would allow accurate troubleshooting by service centers to determine problems with vehicles (Lowrey, Col. 5, Ln. 18~26).

Claims 82, 83, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris in view of Flom and further in view of 'Official Notice'.

Regarding Claim 82,

The combination of Morris and Flom taught all the limitations of claim 81, however did not specifically teach the first wireless access device and the second wireless access device each carry out communications with the replicating device according to an IEEE 802.11 standard.

Morris taught the communication between the portable terminals and the MAS 331 (replicating device) occurs by link 347 (first wireless communication capability) and the communication between the MAS 331 and WAN 333 occurs by link 349 (second wireless communication capability) (Col. 16, Ln. 20~26). Although Morris did not explicitly disclose both wireless communication capabilities are according to an IEEE 802.11 standard, Examiner takes 'Official Notice' in that it was well-known in the art that wireless communications between various devices are based on the popular IEEE 802.11 standard (i.e. 802.11(b) "WiFi").

Regarding Claim 83,

The combination of Morris and Flom taught all the limitations of claim 81, however did not specifically teach the first wireless access device and the second wireless access device each carry out communications with the replicating device according to a Bluetooth specification.

Morris taught the communication between the portable terminals and the MAS 331 (replicating device) utilizing link 347 and the communication between the MAS 331 and WAN 333 occurs by link 349 (second wireless communication capability) (Col. 16, Ln. 20~26). Although Morris did not explicitly disclose both wireless communication capabilities are according to an IEEE 802.11 standard, Examiner takes 'Official Notice'

in that it was well-known in the art that wireless communications between various devices may be based on the popular IEEE 802.11 standard (i.e. 802.11(b) "WiFi").

Regarding Claim 85,

The combination of Morris and Flom taught all the limitations of claim 81, however did not specifically teach the first wireless access device and the second wireless access device each carry out communications with the replicating device according to a wireless local area network (WLAN) specification.

Morris taught the communication between the portable terminals and the MAS 331 (replicating device) occurs by link 347 (first wireless communication capability) and the communication between the MAS 331 and WAN 333 occurs by link 349 (second wireless communication capability) (Col. 16, Ln. 20-26). Although Morris did not explicitly disclose both wireless communication capabilities are according to (WLAN) specification, Examiner takes 'Official Notice' in that it is well-known in the art that wireless communications based on WLAN specification such as the IEEE 802.11 standard is widely used in wireless technologies.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEE SOO KIM whose telephone number is (571)270-3229. The examiner can normally be reached on Monday - Thursday 8:00AM - 5:30PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. K./
07/06/09

/ARIO ETIENNE/

Supervisory Patent Examiner, Art Unit 2457